UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,406	11/03/2000	James P. Tagg	TAG P-3	7866

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EXAMINER
NGUYEN, HAI V

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/706,406	TAGG, JAMES P.
	Examiner	Art Unit	
	Hai V. Nguyen	2142	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>03</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 May 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is

closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8, 11-13b, 15-16, and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 11-13b, 15-16, and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage

application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the communication received on 27 May 2004.

2.   Claims 1-8, 11-13b, 15, 16, and 20 are presented for examination.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1, 11, 12, 13b, 15, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.   Claim 1 recites the limitation of "...**the** configuration of a tunnel....under control of **the** client system, **the** connection to the host system...**the** comparison...**the** mobile system to **the** target network thru **the** fixed system. " in claim 1. There is insufficient antecedent basis for this limitation in the claim.

6.   Claim 11 recites the limitation of " As claimed in 1 where **the** link...". There is insufficient antecedent basis for this limitation in the claim.

7.   Claim 12 recites the limitation of " As claimed in 1 where **the** client configuration...". There is insufficient antecedent basis for this limitation in the claim.

8.   Claim 13b recites the limitation of " As claimed in 1 where **packet**s can be routed thru **the** cellular system to **the** Internet automatically upon loss of **the** fixed wireless connection.". There is insufficient antecedent basis for this limitation in the claim

9.   Claim 15 recites the limitation of " As claimed in 1 where **the** data stream is encrypted, either selectively or prior to being sent to **the** server and decrypted prior to

being sent to the network such that **the** privacy and security of the client are

maintained". There is insufficient antecedent basis for this limitation in the claim.

10.   Claim 20 recites the limitation of " A system as described in 1 where **the**

server...". There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

11.   Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is

required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form.

12.   Claim 20 recites the limitation of "**A system as described in 1** where the server

is any available member located at sufficient physical and or logical distance from the

host that security and privacy are maintained". While claim 1 recites **the method** of

connection to a network.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

14.   Claims 1-8, 11, 12, 13b, 15, 16, and 20 are rejected under 35 U.S.C. 103(a) as

being unpatentable over **Paulsen** et al. U.S. patent no. **6,055,575** in view of **Lynch** U.S.

patent no. **6,487,600 B1**.

15.   As to claim 1, Paulsen, Virtual Private Network System And Method, discloses a

method of connection to a network comprising:

under control of host system, the configuration of a tunnel *(Paulsen, Abstract,*

col. 3, lines 25-61).

under the control of client system, the connection to the host system *(Paulsen,*

Abstract, col. 3, lines 25-61). However, Paulsen does not explicitly disclose a matching

means for comparing system preferences to establish the secure connection between

the mobile system and the target network thru the fixed network. Thus, the artisan

would have been motivated to look into the related networking art for potential system

for implementing under control of a matching means, the comparison of the host system

and client system preferences and, if a match is made, the automatic establishing of a

secure link from the mobile system to the target network thru the fixed system.

In the same field of endeavor, Lynch, related System And Method For Supporting

Multimedia Communications Upon A Dynamically Configured Member Network,

discloses in analogy art, disclose as *an alternate operation, communication are*

accomplished via the Internet or another packet switched network. As compared to the

links established in a telephone network, these links may be called "pseudo links"

because no direct channel is established between network members. However, in

stabling the pseudo links, analogous techniques are employed to ensure that only two

intended network members communicate over the pseudo link. In one embodiment, a

tunnel is setup for each link established and released when the link is complete (Lynch,

col. 3, line 55 – col. 4, line 49; col. 10, 54 – col. 11, line 22; col. 15, line 56 – col. 17, line 15).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention made to have incorporated Paulsen's teachings of providing the control of host and client systems for configuration and connection *(Paulsen, Abstract, col. 3, lines 25-61)* with the teachings of Lynch, for the purpose of *enhancing the security of the link (Lynch, col. 4, lines 40-49).* Paulsen also suggests that *the system also permits an individual to access the private data network without incurring any long distance telephone charges (Paulsen, col. 3, lines 25-61).*

16.   As to claim 2, Paulsen-Lynch discloses wherein the comparison is made in a server *(Lynch, Fig. 23, item 2300).*

17.   As to claim 3, Paulsen-Lynch discloses wherein the fixed network is the Internet *(Lynch, Fig. 23, item 2316 to Internet).*

18.   As to claim 4, Paulsen-Lynch discloses wherein the fixed network is the PSTN *(Lynch, Fig. 23, item 2320 to PSTN).*

19.   As to claim 5, Paulsen-Lynch discloses where the fixed system is, itself, mobile and connected to another fixed system in a manner that can be repeated recursively until a connection to the target network is made *(Lynch, col. 12, lines 1-12; col. 13, line 66 – col. 14, line 13).*

20.   As to claim 6, Paulsen-Lynch discloses where the host systems and the client systems are members of service that givers reciprocal roaming rights *(Lynch, col. 20, lines 1-25).*

21.   As to claim 7, Paulsen-Lynch discloses where the host system publishes a cost of obtaining a link and the mobile client system has a preprogrammed limit to the amount it is willing to pay for a link and of the cost is less than or equal to the limit then the link is automatically established *(Lynch, col. 14, lines 14-59)*.

22.   As to claim 8, Paulsen-Lynch discloses where the host system is not connected to a network and will make connection to that network upon request by a client *(Lynch, col. 21, line 49 – col. 22, line 25)*.

23.   As to claim 11, Paulsen-Lynch discloses where the link is not automatically established out rather the user is given notification of availability of a link that they accept or reject *(Lynch, col. 21, line 49 – col. 22, line 25)*.

24.   As to claim 12, Paulsen-Lynch discloses where the client configuration is performed automatically by the host upon boot up *(Lynch, col. 21, line 49 – col. 22, line 25)*.

25.   As to claim 13b, Paulsen-Lynch discloses where packets can be automatically routed thru multiple connection means under control of the mobile device and server system *(Lynch, col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67)*.

26.   As to claim 15, Paulsen-Lynch discloses where the data stream is encrypted, either selectively or prior to being sent to the server and decrypted prior to being sent to the network such that the privacy and security for the client are maintained *(Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67)*.

27.   As to claim 16, Paulsen-Lynch discloses where the encryption can be selectively applied to the data stream depending on preferences (*Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

28.   As to claim 20, Paulsen-Lynch discloses where the server is nay available member located at sufficient physical or logical distance from the host that security and privacy are maintained (*Lynch, col. 3, line 55 – col. 4, line 49; col. 21, line 49 – col. 22, line 25; col. 35, lines 6-67*).

29.   Further references of interest are cited on Form PTO-892, which is an attachment to this action.

30.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 703-306-0276. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on 703-305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JACK B. HARVEY
SUPERVISORY PATENT EXAMINER

Hai V. Nguyen
Examiner
Art Unit 2142